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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: William T. DONOFRIO et al.

Serial No.: 09/879,319

Group Art Unit: 3731

Confirmation No. 5187

Filed: June 11, 2001

Examiner: NGUYEN, Victor X.

For: FINGER OPERATED SWITCH FOR CONTROLLING A SURGICAL HANDPIECE

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This reply is in response to the Restriction Requirement issued in this application on

November 19, 2002. The Examiner has required restriction to one of the following groups:

Group I (claims 1-30) drawn to a system in surgical procedures, classified in class 606, subclass 169.

{ Group II (claims 31-60 and 66-68) drawn to a system for implementing surgical procedures, classified in class 606, subclass 170.

Group III (claims 61-65) drawn to a method for controlling an ultrasonic surgical handpiece, classified in class 128, subclass 898.

Applicants hereby elect, with traverse, Group II, claims 31-60 and 66-68, drawn thereto, for further prosecution on the merits.

In accordance with Patent Office examining procedures, “if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” (MPEP 803). A serious burden on the Examiner may be *prima facie* shown if the Examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. (MPEP 803).

MPEP 808.02 states, “[w]here, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” (emphasis added). The Examiner acknowledges that the classification and field of search is the same for Group I, claims 1-30 and Group II, claims 31-60 and 66-68, namely class 606. Accordingly, the restriction requirement for these claims should be withdrawn and claims 1-30 should be examined.

Furthermore, the Examiner distinguishes claims 1-30, Group I, as subclass 169 and claims 31-60 and 66-68, Group II, as subclass 170 of the same class 606. Although the Examiner has identified two different subclasses, 169 and 170, of search in class 606, Applicants maintain that the different field of search does not place a serious burden on the part of the Examiner. Cutter having vibratory drive means, subclass 169 and cutter carried on elongated probe-like member, subclass 170, are merely both subclasses of cutting, puncturing or piercing instruments, subclass 167. Thus, pertinent art found can be found for both groups of claims in either of the two subclasses.

In addition, independent claims 1 and 31 are close in scope, where the difference between claim 1 and 31 is the change of the final limitation in claim 31 to "if a monitored pressure on the switch reaches a high threshold...if the monitored pressure reaches a low threshold." Accordingly, for this further reasons claims 1-30 should be examined along with the claims 31-60 and 66-68.

A prompt and favorable official action and the merits of all claims in this application is earnestly solicited. If any additional fees or charges are required in connection with the above-identified application, authorization is hereby given to charge our U.S. Patent and Trademark Deposit Account No. 04-0100.

Respectfully submitted,

Date: December 3, 2002



Alphonso A. Collins
Registration No. 43,559
Attorney for Applicant(s)

DARBY & DARBY
805 Third Avenue
New York, New York 10022
(212) 527-7700